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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,723	09/02/1999	JAY S. WALKER	WD2-99-011	4361
22927	7590	10/22/2003	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			FADOK, MARK A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/388,723

Applicant(s)

WALKER ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29,31-43,45-104,106,107 and 109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29,31-43,45-104,106,107, and 109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Request for Continuing Examination*

The Examiner is in receipt of applicant's reply to Office action mailed 4/30/2003, which was received by the Office 8/4/2003. Acknowledgement is made that no amendments were filed and no terminal disclaimer was provide for the provisional double patent rejection. The arguments presented have been carefully considered and were found to be persuasive. Therefore a new grounds of rejection are provided below.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Please note that a Terminal Disclaimer may not be held in abeyance, therefore should the Applicant respond without a Terminal Disclaimer in their next response it will be considered nonresponsive.

**Claims 1-29,31-43,45-104,106,107 and 109 are provisionally rejected under the judicially created doctrine of double patenting over the claims and specification of copending Applications No. 09/337,906, 09/605,818 and**

**09/540,709. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter, as follows: Both disclose a method for purchasing a product online and passing on information to facilitate a redemption for the purchase at a retailer. The applications also claim features such as transferring said information to a voucher, offering rebates, and providing for the option to provide a substitute.

**Claim 1-29,31-43,45-104,106,107, and 109 are rejected under the judicially created doctrine of double patenting over claim 1-132 of U. S. Patent No. 6,249,772 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both are drawn to a central controller that sells a product a one price that is different from a second price offered by a retailer.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-29,31-43,45-104,106,107, and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (6,512,570), in view of Wollston (6,266,651) and further in view of Official Notice.**

In regards to claims 1-29,31-43,45-104,106,107, and 109 Garfinkle discloses all the features of the instant claims except as follows:

Garfinkle teaches developing a contract between a retailer and a central controller which establishes costs (col 2, lines 1-65), but does not specifically mention that the amount paid to the retailer is different or not based on a second price of the product that a buyer agreed to pay to a party different from the buyer. Woolston teaches consignment terms where an owner of merchandize negotiates terms of payment from the system in exchange for the system selling the product in an auction format (col 4, lines 20-50). The system of Woolston further does not explicitly teach that the payment

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to the retailer is not based on a first price agreed to between the buyer and purchasing system. Wollston does not limit the terms and conditions which can be agreed upon between an owner and the system. Furthermore, it is old and well known to have an owner of goods agree to have another person sell the product for them so long as a minimum amount is received by the owner (reserve price) and allow the seller to keep any amount over this agreed upon amount. It would be obvious to a person of ordinary skill in the art to include payment to the retailer which is not based on a first price agreed to between the buyer and purchasing system and include in Garfinkle an auction/consignment system as taught by Woolston, because the system could then sell the product for potentially a much larger profit than strictly on percentage, this option may also be one that a seller prefers and not offering this option would cause the owner to go elsewhere, also auctions to match sellers and buyers is known to be a successful model for selling products and services and would attract additional buyers who want to negotiate their price for the product.

Garfinkle teaches purchasing a product online and later picking it up at a designated retailer. But does not specifically teach all of the redemption methods of the instant claims. It is old and well known in the art to provide redemption information in the form of a voucher, where the buyer presents this information in return for a product or service. It would be obvious to a person of ordinary skill in the art to include in Garfinkle the redemption methods of the instant claims, because this would provide an alternate means to completing the transaction, which may be more favorable to a buyer and cause the buyer to use the system more frequently.

***Response to Arguments***

Applicant's arguments with respect to claims -29,31-43,45-104,106,107, and 109 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including

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After Final communications labeled

"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled


"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner



WYNNE W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600